

REMARKS/ARGUMENTS

Status of the Application:

Prior to entry of this amendment, claims 1-51 were pending in this application. A final office action mailed 1/13/2004 (Paper no. 16) rejected claims 1-51 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,805,587 ("Norris") in view of U.S. Patent No. 6,498,841 ("Bull"). This amendment amends claims 1, 8, 13, 19, 24, 33, 34 and 44 and adds new claims 52-61. Hence, after entry of this amendment, claims 1-61 will stand pending in the application. It is believed that the new and amended claims clearly are in condition for allowance, and entry of this amendment therefore is requested.

The claims, as amended herein, were filed as part of an amendment after final mailed March 15, 2004, but the amendment was not entered.

Amendments to the claims:

Although the applicant continues to maintain that the cited references fail to create a *prima facie* case of obviousness against the claims pending before entry of this amendment, in the interest of expeditious prosecution, claims 1, 8, 13, 19, 24, 33 and 44 have been amended to place them clearly in condition for allowance. For instance, claim 1 has been amended to recite, *inter alia*, "receiving, at the AIN, an audible identification from the caller . . .," and claim 13 has been amended to recite, *inter alia*, "In an advanced intelligent network (AIN), a communication network computer" (amendments indicated by underlining). Claims 8, 19, 24, 33 and 44 have been amended in similar fashion.

Support for these amendments can be found, *inter alia*, in lines 4-9 on page 4 of the application, which notes that "[t]he telecommunications system 10 is shown implemented in an advanced intelligent network ("AIN") and includes several known programmable components which additionally are programmed to perform the functions described below," as well as lines 12-18 on page 5.

Claim 34 has been amended to correct a typographic error by substituting the term “computer” for “computing.” This amendment provides proper antecedent basis for the limitations of that claim. Claims 8 and 13 have also been amended to correct typographic errors.

New claims 52-61 have been added by this amendment. Each of these new claims recites additional features not present (or even possible) in the cited combination of Norris and Bull. For example, new claim 52 recites, *inter alia*, “allowing a user of the subscriber line to choose to take the call over the computer network or via the subscriber line.” Claims 53-61 include similar limitations. Support for the new claims can be found, *inter alia*, in the existing claims, as well as in lines 15-20 on page 7 of the application.

Rejections under § 103(a):

The office action rejected all of the pending claims as being unpatentable over a combination of Norris and Bull. The applicant respectfully maintains the traversal of these rejections for the reasons stated in the prior response (Paper no. 15). In the interest of expeditious prosecution, however, the independent claims in the application have been amended, and the applicant submits that the claims as amended are allowable over the cited combination for the additional reasons discussed below.

The final office action asserts that the systems of Norris and Bull may be combined to teach all of the limitations of the claims. In making this assertion, the final office action appears to concede that Norris operates by automatically forwarding a call outside of the PSTN to a separate Internet Access Service (IAS) for processing if the user is online, while Bull teaches, primarily, that the PSTN handles the functions of obtaining caller information and transmitting that information to the user. The respective disclosures of Bull and Norris, therefore, would appear to be incompatible, since once the call is forwarded to the IAS in accordance with Norris’ teaching, the PSTN components taught by Bull would be unavailable to perform the cited functions. The final office action, however, relies on a brief passage in Bull (c. 3, ll. 12-14) that notes that “the system 100 can be implemented in a computer network or any other network that is adapted to store and retrieve information.” The final office action implicitly admits, therefore, that in order to combine Norris and Bull in any operative fashion, a

call must be forwarded (as taught by Norris) to an IAS outside the PSTN that functions in the manner disclosed by Bull. Basically, then, in the combination asserted by the final office action, none of the caller identification takes place within the PSTN.

This combination, however, fails to disclose the limitations of the claims as pending. For instance, claim 1 recites, *inter alia*, “receiving, at the AIN, an audible identification from the caller . . . ,” (emphasis added) and one skilled in the art would recognize that an AIN is one particular type of PSTN. In contrast, the asserted combination would function to receive the audible identification at the IAS, since by the time the caller provided such identification, the call already would have been transferred outside the PSTN. As noted in the previous response (Paper no. 15), Norris (c. 5, ll. 53-64) explicitly teaches that

“CO 25 determines that station S1 is busy (and that call forwarding has been activated) at station S1. As such CO 25, in a conventional manner, directs the call to IAS 200 in accord with the call forwarding telephone number that CO 25 received as interacting with IAS 200 in the manner discussed above. In doing so, CO 25 sends a message to TS 105 requesting a rerouting of the station S2 call and containing the IAS 200 telephone number as the destination for such rerouting.”

Norris (and, by extension, the cited combination of Norris and Bull), therefore, explicitly teaches that the incoming call is forwarded automatically before any call processing can take place. Under these circumstances, it would be impossible for the PSTN to receive an audible identification from the caller, as recited in claim 1, because the PSTN no longer has control of the call when the identification procedures are performed by Bull’s system. For this reason, even if Norris and Bull could be combined to produce an operative system, that system would not be able to function in the manner recited by claim 1. Claim 1, therefore, is allowable over the cited combination of Bull and Norris. As independent claims 8, 13, 19, 24, 33 and 44 include similar limitations, those claims likewise are allowable, and dependent claims 2-7, 9-12, 14, 18, 20-23, 25-32, 34-43, 45-51 and 56-61 are allowable as depending from allowable base claims as well as being directed to specific novel substitutes.

New claims 52-61 are allowable for additional reasons. As an example, new claim 52 recites, *inter alia*, “allowing a user of the subscriber line to choose to take the call over the computer network or via the subscriber line.” Neither of the cited references discloses this

limitation. Moreover, as argued in the applicant's previous response, any cited combination that includes Norris would be unable to provide this functionality, since Norris, as discussed above, automatically forwards the call to a separate IAS, preventing the further use of the PSTN (and, by extension, the subscriber line) to connect the call. For this reason, the only method disclosed by Norris (c. 7, l. 5 – c. 8, l. 1) to connect the call is via the computer network. Thus, not only do both Norris and Bull fail to disclose this limitation, but any attempt to modify the references to function in this manner would substantially change Norris' principle of operation. Only the novelty of the present invention, which enables the collection of caller information within the AIN, can provide this feature to a user. Claim 52, for at least this additional reason, is allowable over the cited combination of Norris and Bull. Claims 53-61, which include similar limitations, are also allowable.

CONCLUSION

In view of the foregoing, the applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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